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LETT, THOMAS J

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFFREY G. WILEY

Appeal 2009-0492
Application 10/002,354
Technology Center 2600

Decided:¹ May 6, 2009

Before KENNETH W. HAIRSTON, ROBERT E. NAPPI, and
KARL D. EASTHOM, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 25. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm the Examiner's rejection of these claims.

INVENTION

The invention is directed towards a multifunction device that converts a paper document to an electronic image and delivers the document to a multitude of network destinations. *See* Spec. 4:10-22. Claim 18 is representative of the invention and reproduced below:

18. A multifunction device comprising computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying different types of network destinations to receive a document, program code for automatically determining at least one document property for optimizing output at each of said different types of network destinations, program code for formatting the at least one document property of said document for each of said different types of network destinations, and program code for sending said formatted document from said multifunction device to each of said different types of network destinations, wherein said document is imaged only once for delivery to each of said different types of network destinations.

REFERENCES

Daniels	US 6,343,327 B2	Jan. 29, 2002 (filed Nov. 12, 1997)
Czyszczewski	US 6,577,907 B1	Jun. 10, 2003 (filed Apr. 24, 2000)

Quine

US 6,782,415 B1

Aug. 24, 2004
(filed Nov. 3, 2000)

REJECTIONS AT ISSUE

The Examiner rejected claim 18 under 35 U.S.C. § 102(e) as being anticipated by Czyszczeewski.

The Examiner rejected claims 1 through 7, 11 through 14, and 19 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Czyszczeewski in view of Quine.

The Examiner rejected claims 8 through 10, 15 through 17, and 24 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Czyszczeewski in view of Quine and Daniels.

ISSUE

Rejection of claim 18 under 35 U.S.C. § 102(e) as being anticipated by Czyszczeewski

Appellant argues on pages 5 through 7 of the Appeal Brief and pages 3 through 5 of the Reply Brief that the Examiner's rejection of claim 18 is in error. Appellant argues that Czyszczeewski does not teach automatically determining a document property for optimizing output or program code for formatting the document property of said document. App. Br. 6; Reply Br. 3-5.

Thus, with respect to claim 18, Appellant's contention presents us with the issue: has Appellant shown that the Examiner erred in finding Czyszczeewski teaches automatically determining a document property for optimizing output and formatting the document property?

Rejection of claims 1 through 7, 11 through 14, and 19 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Czyszczewski in view of Quine

Claim 1

Appellant argues on page 8 of the Appeal Brief that the Examiner's rejection of claim 1 is in error. Appellant's arguments rely upon the same reasoning as asserted with respect to claim 18.

Thus, with respect to claim 1, Appellant's contentions present us with the same issue as claim 18.

Claims 2-7

Appellant argues on page 8 of the Appeal Brief that claims 2-7 are allowable based upon their dependency on claim 1. Thus, Appellant's argument with respect to the Examiner's rejection of claims 2-7 presents us with the same issue as claim 1.

Claim 11

Appellant argues on page 9 of the Appeal Brief that the Examiner's rejection of claim 11 is in error. Appellant's arguments rely upon the same reasoning as asserted with respect to claim 18.

Thus, with respect to claim 11, Appellant's contentions present us with the same issue as claim 18.

Claims 12-14

Appellant argues on page 9 of the Appeal Brief that claims 12-14 are allowable based upon their dependency on claim 11. Thus, Appellant's

argument with respect to the Examiner's rejection of claims 12-14 presents us with the same issue as claim 11.

Claims 19-23

Appellant argues on page 9 of the Appeal Brief that claims 19-23 are allowable based upon their dependency on claim 18. Thus, Appellant's argument with respect to the Examiner's rejection of claims 19-23 presents us with the same issue as claim 18.

Rejection of claims 8-10, 15-17, and 24-25 under 35 U.S.C. § 103(a) over Czyszczewski in view of Quine and Daniels

Claims 8-10

Appellant argues on page 10 of the Appeal Brief that claims 8-10 are allowable based upon their dependency on claim 1. Thus, Appellant's argument with respect to the Examiner's rejection of claims 8-10 presents us with the same issue as claim 1.

Claims 15-17

Appellant argues on page 10 of the Appeal Brief that claims 15-17 are allowable based upon their dependency on claim 11. Thus, Appellant's argument with respect to the Examiner's rejection of claims 15-17 presents us with the same issue as claim 11.

Claims 24-25

Appellant argues on page 10 of the Appeal Brief that claims 24-25 are allowable based upon their dependency on claim 18. Thus, Appellant's argument with respect to the Examiner's rejection of claims 24-25 presents us with the same issue as claim 18.

FINDINGS OF FACT

1. Czczyszczewski teaches a modular multifunction device that includes a scanner, printer, and multifunctional controller with a graphical user interface (GUI). The device is used to scan, print, copy, and send/receive faxes and e-mails. Col. 1, ll. 47-52.
2. The multifunctional controller is coupled to the scanner component or components in order to rapidly convert scanned documents to a desired format. Col. 2, ll. 52-56.
3. When a document is scanned, the user is able to select a network destination or destinations, which include fax machines, local printers, network printers, Internet addresses and e-mail. Col. 7, ll. 12-25.
4. As a result of the network destination(s) selected, the device determines document properties related to the destination(s) and displays them on the GUI. Col. 12, ll. 33-42.
5. When a user selects the printer destination, the system automatically determines and the GUI displays the document property related to whether the document should be printed in black and white option. Col. 12, ll. 33-42 and Fig. 9A.

6. When a user selects the e-mail destination, the system automatically determines and the GUI displays the document property related to whether the document should be sent as a PDF or text file. Col. 12, ll. 33-42 and Fig. 9D.
7. After these document properties are selected by the user, the user presses the Start key to begin the selected job. Col. 11, ll. 58-63 and Fig. 8B.
8. The data is then transformed into the appropriate format and is sent to the selected network destination. Col. 8, ll. 12-24.

PRINCIPLES OF LAW

Office personnel must rely on Appellants' disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc). “[I]nterpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.” *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348 (Fed. Cir. 2002) (internal quotation marks and citations omitted; emphasis in original).

It is well settled that in order for the Examiner to establish a prima facie case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally In re Schreiber*, 128 F.3d 1473, 1477; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

ANALYSIS

Rejection of claim 18 under 35 U.S.C. § 102(e) as being anticipated by Czyszczewski

Appellant's arguments have not persuaded us that the Examiner erred in rejecting claim 18. Claim 18 recites "program code for automatically determining at least one document property for optimizing output at each of said different types of network destinations, [and] program code for formatting the at least one document property of said document for each of said different types of network destinations." Appellant's Specification does not specifically define the term "document property." However, Appellant indicates that a "document property" may be: a draft, whether the document is black/white or color, the document compression, or the document file and/or file type including bitmap or hypertext. Spec. 13:29-33. Thus, we consider the scope of the claim term "document property" to also include whether the document should be in a PDF or text format and whether the document is to be printed in black and white.

Appellant argues that Czyszczewski does not disclose optimizing the output by determining at least one document property. App. Br. 17. However, Czyszczewski teaches a modular multifunction device that includes a scanner, printer, and multifunctional controller with a graphical user interface (GUI) used to scan, print, copy, and send/receive faxes and e-mails. FF 1. The multifunctional controller is coupled to the scanner component or components. FF 2. In operation, a user scans a document and then selects a network destination, or destinations. FF 3. The system determines document properties and displays the document properties related to that particular delivery method on the GUI. FF 4. For instance, when the user intends to send the scanned data to a printer, the system automatically determines and the GUI displays the document property related to whether the document should be printed in black and white. FF 5. When the user intends to send the scanned data via e-mail, the system automatically determines and the GUI displays the document property related to whether the document should be sent as a PDF file or a text file. FF 6. While these properties are selected based upon the user's preference, the properties are automatically determined and presented to the user based upon the type of destination originally selected. Once the properties are selected by the user, the user presses the Start key to begin the selected job. FF 7. The data is then transformed into the appropriate format and is sent to the selected network destination. FF 8. Therefore, Czyszczewski does teach automatically determining a document property for optimizing output and formatting the document property for each of the network destinations. Thus, we sustain the Examiner's rejection.

Rejection of claims 1 through 7, 11 through 14, and 19 through 23 under 35 U.S.C. § 103(a) as being unpatentable over Czyszczewski in view of Quine

Claim 1

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 1. Claim 1 contains similar limitations to claim 18. Appellant's arguments present the same issues discussed with respect to claim 18 (App. Br. 8). Therefore, we sustain the Examiner's rejection of claim 1 for the reasons discussed *supra* with respect to claim 18.

Claims 2-7

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 2-7. Claims 2-7 ultimately depend upon claim 1. Appellant's arguments present the same issues discussed with respect to claim 1 (App. Br. 8). Therefore, we sustain the Examiner's rejection of claims 2-7 for the reasons discussed *supra* with respect to claim 1.

Claim 11

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 11. Claim 11 ultimately depends upon claim 18. Appellant's arguments present the same issues discussed with respect to claim 18 (App. Br. 9). Therefore, we sustain the Examiner's rejection of claim 11 for the reasons discussed *supra* with respect to claim 18.

Claims 12-14

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 12-14. Claims 12-14 ultimately depend upon claim 11. Appellant's arguments present the same issues discussed with respect to claim 11 (App. Br. 9). Therefore, we sustain the Examiner's rejection of claims 12-14 for the reasons discussed *supra* with respect to claim 11.

Claims 19-23

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 19-23. Claims 19-23 ultimately depend upon claim 18. Appellant's arguments present the same issues discussed with respect to claim 18 (App. Br. 9). Therefore, we sustain the Examiner's rejection of claims 19-23 for the reasons discussed *supra* with respect to claim 18.

*Rejection of claims 8-10, 15-17, and 24-25 under 35 U.S.C. § 103(a) over
Czyszczewski in view of Quine and Daniels*

Claims 8-10

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 8-10. Claims 8-10 ultimately depend upon claim 1. Appellant's arguments present the same issues discussed with respect to claim 1 (App. Br. 10). Therefore, we sustain the Examiner's rejection of claims 8-10 for the reasons discussed *supra* with respect to claim 1.

Claims 15-17

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 15-17. Claims 15-17 ultimately depend upon claim 11. Appellant's arguments present the same issues discussed with respect to claim 11 (App. Br. 10). Therefore, we sustain the Examiner's rejection of claims 15-17 for the reasons discussed *supra* with respect to claim 11.

Claims 24-25

Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 24-25. Claims 24-25 ultimately depend upon claim 18. Appellant's arguments present the same issues discussed with respect to claim 18 (App. Br. 10). Therefore, we sustain the Examiner's rejection of claims 24-25 for the reasons discussed *supra* with respect to claim 18.

CONCLUSIONS OF LAW

Appellant has not shown that the Examiner erred in finding that Czyszczewski teaches automatically determining a document property for optimizing output and formatting the document property.

SUMMARY

The Examiner's rejection of claims 1 through 25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

Appeal 2009-0492
Application 10/002,354

AFFIRMED

ELD

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